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Name: Elie H. Gendloff
Signature:

Applicant	:	Bruce D. Gaynor et al.
Serial No.	:	08/833,838
Filed	:	April 10, 1997
For	:	PEPTIDES FOR THE TREATMENT AND DIAGNOSIS OF SYSTEMIC LUPUS ERYTHEMATOSUS
Examiner	:	G.R. Ewoldt, Ph.D.
Group Art Unit	:	1644

RESPONSE TO ADVISORY ACTION OF AUGUST 8, 2001 UNDER 37 C.F.R. 1.116

Commissioner for Patents
Washington, D.C. 20231

Sir:

This paper is filed in response to the Advisory Action of August 8, 2001 in the above case. Since a Notice of Appeal was filed on July 9, 2001, it is believed that this Response is timely filed.

REMARKS

Rejections under 35 U.S.C. 102(a)

Claims 54 and 63-74 stand rejected under 35 U.S.C. 102(a) as being anticipated by Gaynor et al., 1997, Proc. Nat'l. Acad. Sci. USA 94:1955-1960; Claims 54, 63-66 and 71-74 also stand rejected under 35 U.S.C. 102(a) as being anticipated by Spatz et al., 1997, METHODS: A Companion to Methods in Enzymology 11:70-78. A Declaration under 37 C.F.R. 1.131 was submitted by Inventors Gaynor, Diamond, Scharff, and Valadon on July 9, 2001 attesting that the authors of the above publications that are not

inventors did not contribute to the conception of the invention. However, the rejection was maintained in the Advisory Action of August 8, 2001 because inventors Scharff and Valadon are not authors of Spatz et al. It was asserted that it was unclear how inventors Scharff and Valadon could be inventors but not authors of their own work.

Applicants respectfully request reconsideration and withdrawal of the current rejection in light of the following comments.

An inventor is one who has conceived the claimed subject matter. Sewall v. Walters, 30 USPQ2d 1356, 1358 (Fed Cir. 1994). Conception exists when a definite and permanent idea of an operative invention, including every feature of the subject matter sought to be patented, is known. *Id.* at 1358-1359, citing Coleman v. Dines, 224 USPQ 857, 862 (Fed. Cir. 1985). It is well settled that a person who contributes to the conception of any one claim is an inventor of the whole patent. Thus, the conception of the invention described in a subset of the claims could have been contributed by some of the inventors but not others.

In the instant case, Applicants continue to maintain that the inventorship of this application is correct; that is, that each person listed as an inventor contributed to the conception of at least one pending claim. It is further noted that some claims were held to be allowable but others were held to be anticipated by the one or both of the cited references. Thus, not all of the claims were anticipated by the cited references. It should thus be conceivable that Scharff and Valadon could be inventors (i.e., contribute to the conception of at least one of the claims) but not authors of a publication that anticipates only some of the claims.

While patent inventorship has a legal definition, such that a particular person is either an inventor or is not (without option), there is no such legal standard for determining who will be an author of a scientific publication. Some scientists believe that everyone that made even the smallest contribution to the publication should be an

author, while other scientists believe that an author should make a more significant contribution. Indeed, the undersigned attorney has published works where some of the coauthors made no contribution to the work except to provide research funds from a grant; the undersigned attorney also knows of scientific papers where a person significantly contributed to the conception of the work presented in the publication but was not an author of the publication. Therefore, the presence or absence of a particular person as an author of a scientific publication does not necessarily have anything to do with whether that particular person contributed to the conception of an invention disclosed in the publication. This is particularly true of a review article such as Spatz et al. Although Spatz et al. discloses some information relating to some of the claims of the present application, it is clearly primarily a review article as indicated by the large number of citations (106) as well as the lack of a "Materials and Methods" section. As a review article, Spatz et al. discusses some information relating to the present invention in the context of the overall subject being reviewed. It is also noted that Spatz et al. discusses the work of a number of other scientists without including them as authors of the review. However, the lack of Scharff and Valadon as an author of Spatz et al. does not necessarily mean that they did not contribute to the conception of the various aspects of the instant invention that is disclosed in that paper, nor does it say anything about whether Scharff and Valadon contributed to the conception of other aspects of the invention that is <u>not</u> disclosed in Spatz et al.

It is also noted that Scharff and Valadon <u>are</u> authors of Gaynor et al., which is truly a publication disclosing the results of scientific research, as indicated by the "Materials and Methods" section, as well as the more modest number of citations (25).

The Declaration submitted on July 9, 2001 served the purpose for which it was intended, that is to declare that the aspects of the Gaynor and Spatz publications that relate to the conception of the present invention were contributed solely by inventors of

the publication. This is all that is required for a 37 C.F.R. 1.131 declaration. See MPEP 715; MPEP 715.01(c). For a 131 declaration to effectively "swear behind" a reference, there is no requirement that all of the inventors are authors of the reference.

In light of the above discussion, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. 102(a) and passage of the claims to allowance. Should there be any additional matters that prevent allowance of the claim, the Examiner is urged to contact the undersigned attorney.

Respectfully submitted,

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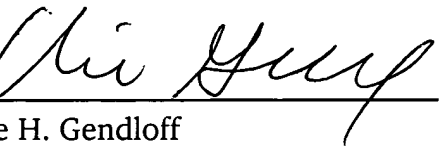
September 7, 2001

By: 
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